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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/821,184	03/29/2001	Kenneth A. Parulski	75276CRC	6403

7590 06/03/2003  
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EXAMINER

LAMB, TWYLER MARIE

ART UNIT	PAPER NUMBER
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2622

DATE MAILED: 06/03/2003

6

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/821,184

Applicant(s)

PARULSKI ET AL.

Examiner

Twyler M. Lamb

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 24 March 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1,2,5,6,9,10,13,14 and 17 is/are rejected.
- 7) ☒ Claim(s) 3-4, 7-8, 11-12 and 15-16 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-2, 5-6, 9-10, 13-14 and 17 are rejected under 35 U.S.C. 102(b) as being anticipated by Sarbadhikari et al. (US 5,477,264).

With regard to claim 1, Sarbadhikari et al. discloses an electronic printing system (Figure 1, electronic still photography system, col 4, lines 1-6) for printing images stored on a removable memory card (removable memory card 3), the electronic printing system (Figure 1, col 4, lines 1-6) comprising: a memory card interface (memory card slot 2) for receiving the removable memory card (col 4, lines 2-6), the removable memory card (removable memory card 3) having stored thereon a plurality of digital image files (col 4, lines 6-9) and a print utilization file (col 4, lines 37-42), the print utilization file (col 4, lines 37-42) identifying at least two digital images files stored on the removable memory card to be printed (which reads on the memory card containing data files, therefore there would be at least two data files stored on the memory card) (col 4, lines 37-42), the at least two digital image files corresponding to selected ones of a plurality of digital images captured by a digital camera adapted to receive the removable memory card (which reads on the memory card containing data files, therefore there

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would be at least two data files stored on the memory card) (col 4, lines 37-42); a processor (built-in memory card reader 5; col 4, lines 2-6) coupled to the memory card interface (memory card slot 2) for reading the print utilization files stored on the removable memory card (removable memory card 3) and the digital image files identified in the print utilization file (col 4, lines 37-42); a print engine (printer 6) coupled to the processor for producing prints of the at least two stored digital files identified in the print utilization file (col 10, lines 12-23).

With regard to claim 10, Sarbadhikari et al. discloses a method (Figure 1, electronic still photography system, col 4, lines 1-6) for printing images stored on a removable memory card (removable memory card 3), the method comprising the steps of: providing a removable memory card (removable memory card 3) having stored thereon a plurality of digital image files (col 4, lines 6-9) and a print utilization file (col 4, lines 37-42), the print utilization file (col 4, lines 37-42) identifying at least two digital files stored on the removable memory card (removable memory card 3) to be printed (which reads on the memory card containing data files, therefore there would be at least two data files stored on the memory card) (col 4, lines 37-42), the at least two digital image files corresponding to selected ones of a plurality of digital images captured by a digital camera adapted to receive the removable memory card (which reads on the memory card containing data files, therefore there would be at least two data files stored on the memory card) (col 4, lines 37-42); reading (built-in memory card reader 5; col 4, lines 2-6) the print utilization file (col 4, lines 37-42) stored on the removable memory card (removable memory card 3) and the digital image files identified in the print utilization

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file (which reads on the memory card containing data files, therefore there would be at least two data files stored on the memory card) (col 4, lines 37-42); and producing prints of the at least two stored digital image files identified in the print utilization file (col 10, lines 12-23).

With regard to claim 2, Sarbadhikari et al. also discloses further including an internal memory (image buffer 18) for storing at least a portion of one digital image file to be printed (col 10, lines 9-58).

With regard to claim 5, Sarbadhikari et al. also discloses wherein the print utilization file further includes the file type of each digital image file (which reads on the stored image signals being of the JPEG type) (col 6, lines 26-37).

With regard to claim 6, Sarbadhikari et al. also discloses wherein the file type of at least one digital file is a JPEG file type (col 6, lines 26-37).

With regard to claim 9, Sarbadhikari et al. also discloses wherein the print utilization file further identifies a template to be combined with a particular digital image file to form a composite image to be printed (col 10, lines 24-53).

With regard to claim 13, Sarbadhikari et al. also discloses wherein the print utilization file further includes the file type of each digital image file (which reads on the stored image signals being of the JPEG type) (col 6, lines 26-37).

With regard to claim 14, Sarbadhikari et al. also discloses wherein the file type of at least one digital file is a JPEG file type (col 6, lines 26-37).

With regard to claim 17, Sarbadhikari et al. also discloses wherein the print utilization file further identifies a template to be combined with a particular digital image file to form a composite image to be printed (col 10, lines 24-53).

***Allowable Subject Matter***

1. Claims 3-4 and 11-12 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 3 and 11 identify the uniquely distinct features "wherein the print utilization file further includes the quantity of prints to be printed for each digital image file".

Claims 4 and 12 identify the uniquely distinct features "wherein the print utilization file further includes the size of the prints to be printed for each digital image file".

Claims 7 and 15 identify the uniquely distinct features "wherein the print utilization file further includes a customer name and a mailing address of such customer".

Claims 8 and 16 identify the uniquely distinct features "wherein the print utilization file further includes a credit card number of the customer".

***Response to Arguments***

2. Applicant's arguments, see Response, filed 3/24/03, with respect to claims 3-4, 7-8, 11-12 and 15-16 have been fully considered and are persuasive. The rejections of claims 3-4, 7-8, 11-12 and 15-16 has been withdrawn and now they stand objected to because they depend on rejected base claims.

3. Applicant's arguments filed 3/24/03 regarding claims 1-2, 5-6, 9-10, 13-14 and 17 have been fully considered but they are not persuasive.

Applicant argues that Sarbadhikari does not disclose the claimed print utilization file as set forth in independent claims 1 and 10. Applicant argues that the portion of Sarbadhikari does not disclose a print utilization file that identifies "at least two digital image files...to be printed as set forth in independent claims 1 and 10.

Sarbadhikari discloses the print utilization file identifying at least two digital images files stored on the removable memory card to be printed (which reads on the memory card containing data files, therefore there would be at least two data files stored on the memory card) (col 4, lines 37-42).

Applicant's arguments with respect to claims 3-4, 7-8, 11-12 and 15-16 have been considered but are moot in view of the new ground(s) of rejection.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Twyler Lamb whose telephone number is 703 - 305-8823. The examiner can normally be reached on M-TH (8:30-5:00).

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Edward L Coles can be reached on 703-305-4712. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-6036 for regular communications and 703-872-9314 for After Final communications.

Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, DC 20231

or faxed to:

(703) 872-9314

(for informal or draft communications, such as proposed amendments to be discussed at an interview; please label such communications "PROPOSED" or "DRAFT")

or hand-carried to:

Crystal Park Two  
2121 Crystal Drive  
Arlington, VA.  
Sixth Floor (Receptionist)

Twyler Lamb

A handwritten signature in black ink, appearing to be 'Twyler Lamb', written over the typed name.

June 2, 2003